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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 09/917,965 | 07/30/2001 | Herbert Martin Wilson | N1205-014 | 1608 |
| 6449 | 7590 | 01/30/2004 | EXAMINER | |
| ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005 | | | HELMER, GEORGIA L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1638 | |

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,965

Applicant(s)

WILSON ET AL.

Examiner

Georgia L. Helmer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 December 2003 has been entered.

Status of the Claims

2. The Office acknowledges receipt of Applicants Response; dated 29 December 2003.
3. Applicant has amended claim 22; claims 22-28 are pending and are examined in the instant action.
4. Receipt of a marked-up copy of Applicant's substitute specification is acknowledged but it not entered. The substitute specification needs to be accompanied by a statement that the marked up and clean copy are the same, and include no new matter.
5. All rejections not addressed below have been withdrawn.
6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112 second paragraph

7. Claims 22-28 remain rejected under 35 U.S.C. 112, second paragraph for reasons of record.

In claim 22, how is the purpose of step (c) different from step (d)? These steps appear to be identical.

- Claim 22 (e) "having growing Type II": growing Type II what?
- Claim 22 (f): the amendment "[[said]]" is unclear. The "said" embryo structures lacks antecedent basis. Where did the embryos structures come from? What are they?
- in 22 (f), "plants" should be changed to "plant" for proper antecedence.

In claim 24, for clarification, "stock" should be inserted after the second "Agrobacterium" recitation.

Claim Rejections - 35 USC § 112

8. Claims 22-28 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 22 (a): Applicant has amended "gene" to recite "genetic element". The recited "genetic element" is new matter, not supported by the specification as originally filed.

Applicant traverses, stating primarily that "genetic element is a well known term by persons of ordinary skill in the art .

Applicant's traversal has been considered and is unpersuasive. Applicant has not addressed the new matter issue. A well known term not supported the specification constitutes new matter.

Claim Rejections - 35 USC § 103

9. Claims 22-25 and 28 remain rejected over Hansen, G. (US # 6,162,965), Bhojwani, SS et al (Developments in Crop Science, vol 5, pp 24-41, 198), Holton (US 5,948,955), Applicant's admitted prior art, and Stomp (US 6,040,498), for reasons of record, partly repeated below from the Office Action of 30 December 2002.

- Applicant traverses, stating primarily that the cited references, when viewed separately or in combination, do not teach or suggest the claimed invention. Applicant's traversal has been considered and is unpersuasive because the combination of references properly render the claimed invention *prima facie* obvious, for reasons of record.
- Applicant traverses, stating primarily that the Examiner has used an impermissible "obvious to try" standard in reaching the conclusion that Applicant's invention is obvious.

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Applicant's traversal has been considered and is unpersuasive because

Applicant has provided no evidence that the Office used an "obvious to try" standard.

- Applicant traverses, stating primarily that none of the references cited by the Examiner discloses or suggests using 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide. And that therefore, there is not a prima facie case of obviousness.

Applicant's traversal has been considered and is unpersuasive because

Applicant's argument is not commensurate in scope with the claims. None of the claims recite the combination of 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide.

Therefore the rejection is maintained.

- Applicant traverses, stating primarily that Examiner has randomly picked bits or prior art references using the hindsight reasoning provided by Applicant's disclosure.

Applicant's traversal has been considered and is unpersuasive because

Applicant has provided no evidence as to why Applicant believes the Office has used hindsight reasoning.

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- Applicant traverses, stating primarily that the Examiner's imputed conclusion of obviousness could only have been reached with the benefit of the hindsight application of the teachings of the present specification.

Applicant's traversal has been considered and is unpersuasive because

Applicant has provided no evidence that the Office has used hindsight, as discussed above.

Accordingly, these rejections are maintained.

REMARKS

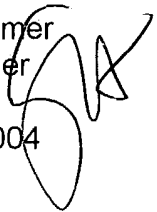
10. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0976. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer
Patent Examiner
Art Unit 1638
January 26, 2004



Amy Nelson for
Phuong Bui

AMY J. NELSON, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600